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SUPREME COURT OF THE UNITED STATES

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No. 946

HUGH W. SANFORD,

Petitioner,

vs.

ROBERT C. KEPNER,

Respondent

BRIEF OF RESPONDENT IN OPPOSITION TO PETITION

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SUPREME COURT, U.S.

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INDEX

	Page
Opinions Below	1
Jurisdiction	1
Statement	2
Summary of Argument	3
Argument	3
Conclusion	7

TABLE OF CASES

Aetna Life Ins. Co. v. *Haworth*, 300 U.S. 227, 81 L. Ed. 617	5
Gandy v. *Marble*, 122 U.S. 432, 30 L. Ed. 1223	4
Heitmuller v. *Stokes*, 256 U.S. 359, 65 L. Ed. 990	5
Helis v. *Ward*, 308 U.S. 365, 84 L. Ed. 327	4
Helvering v. *Taylor*, 293 U.S. 507, 79 L. Ed. 623	4
Hoover v. *Coe*, 325 U.S. 79, 89 L. Ed. 1488	4
Knutson v. *Gallsworthy* (C.A.D.C.) 164 F. 2d 497	6
Little v. *Bowers*, 134 U.S. 547, 33 L. Ed. 1016	5
Milburn v. *Davis-Bournonville Co.*, 270 U.S. 390, 70 L. Ed. 651	4
Mills v. *Green*, 159 U.S. 651, 40 L. Ed. 293	5
Minneapolis Honeywell Regulator Co. v. *Gas Specialty Co.* (C.C.A. 7), 174 F. 2d 203	6
Triplett v. *Line Material Co.* (C.C.A. 7), 133 F. 2d 533	6
United States v. *Munsingwear*, 340 U.S. 36, 95 L. Ed. 36	5

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OCTOBER TERM, 1951

No. 746

HUGH W. SANFORD,

Petitioner,

vs.

ROBERT C. KEPNER,

Respondent

BRIEF OF RESPONDENT IN OPPOSITION TO PETITION

Opinions Below

The opinion of the United States District Court for the Middle District of Pennsylvania, setting forth its findings of fact and conclusions of law, appears at pages 8a-17a of Sanford's Record (S. R.) and is reported in 99 F. Supp. 221, 90 U. S. P. Q. 188. The opinion of the United States Court of Appeals for the Third Circuit is reported in 93 U. S. P. Q. 57.

Jurisdiction

Petitioner's alleged basis for jurisdiction to review this proceeding is Title 28 U. S. Code, Sec. 1254, which prescribes the methods of review by this Court of cases or controversies in courts of appeals. He also relies on Supreme Court Rule 38, 5(b).

Statement

Sanford, petitioner herein, and Kepner, respondent herein, were in interference in the Patent Office with respect to certain counts. The Board of Interference Examiners of the Patent Office adjudged Kepner the prior inventor (S. R. 22) and he thereupon received a patent containing, as claims, the counts of the interference (S. R. 8).

Sanford instituted this action under R. S. 4915 (U. S. C. Title 35, Sec. 63) in the District Court wherein he sought to obtain a judgment authorizing the Commissioner of Patents to issue to him a patent for the counts involved. His complaint raised the issues of priority of invention and patentability of the counts to Kepner (S. R. 3-8). No counterclaim was filed by Kepner.

The District Court, like the Patent Office, found that Sanford was not the prior inventor (S. R. 17). On this basis it entered a judgment dismissing the complaint. The Court found it unnecessary to pass upon the patentability of the counts involved (S. R. 9).

The Court of Appeals, too, found the issue of priority against Sanford (S. R. 124) and, in affirming the judgment of the District Court, would not direct it to pass upon the patentability of the counts (S. R. 128).

In his petition for certiorari Sanford does not challenge the findings of the Patent Office, the District Court and the Court of Appeals that he was not the prior inventor of the subject matter of the counts. The only "Question Presented" in this Court by him is this:

> "Should the District Court have decided the issue of patentability, in a suit under Sec. 4915, R. S., of the counts of the interference, first and foremost, even though the issue of priority be decided in this suit, against the plaintiff?"

Summary of Argument

I. Petitioner having acquiesced in the adverse decisions below on the issue of priority, a case or controversy under R. S. 4915 does not now exist.

II. Absent a case or controversy, the "Question Presented" is moot and not subject to review by this Court.

III. No conflict exists between decisions under R. S. 4915 on denial of relief to a plaintiff who concedes he is not the first inventor of the subject matter involved.

ARGUMENT

I

Petitioner Having Acquiesced in the Adverse Decisions Below on the Issue of Priority, a Case or Controversy under R.S. 4915 Does Not Now Exist.

R. S. Sec. 4915 (35 U. S. C. Sec. 63), so far as is here pertinent, is:

> "*Whenever* a patent on application is refused by the Board of Appeals or whenever *any applicant is dissatisfied with the decision of the board of interference examiners, the applicant,* unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, *may have remedy by bill in equity,* if filed within six months after such refusal or decision; *and the court having cognizance thereof,* on notice to adverse parties and other due proceedings had, *may adjudge that such applicant is entitled,* according to law, *to receive a patent for his invention,* as specified in his claim or for any part thereof, as the facts in the case may appear. *And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue*

> *such patent* on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. * * *" (Italics ours.)

The only case or controversy over which a court has jurisdiction under R. S. 4915 is one to determine whether the plaintiff is entitled to a patent. *Gandy* v. *Marble*, 122 U. S. 432, 30 L. Ed. 1223; *Hoover* v. *Coe*, 325 U. S. 79, 89 L. Ed. 1788. As stated in *Gandy* v. *Marble* (p. 440 of 122 U. S.):

> "All that the court which takes cognizance of the bill in equity, under section 4915, is authorized to do is to adjudge whether or not 'the applicant is entitled, according to law, to receive a patent,' and, after an adjudication in his favor to that effect, the commissioner is not authorized to issue a patent unless the applicant otherwise complies with the requirements of law."

And a plaintiff who is not the first inventor, is not entitled to a patent. *Milburn* v. *Davis-Bournonville Co.*, 270 U. S. 390, 402, 70 L. Ed. 651, 654, states:

> "The fundamental rule we repeat is that the patentee must be the first inventor."

This Court will consider only the question presented by the petition. *Helvering* v. *Taylor*, 293 U. S. 507, 511, 79 L. Ed. 623, 627. *Helis* v. *Ward*, 308 U. S. 365, 370, 84 L. Ed. 327, 329. Wherefore, Petitioner, by failing to question the affirmance by the court below of the findings of the lower tribunals adverse to him on the issue of priority of invention, is bound as to that issue by the affirmance and must be taken as having conceded that he is not the first inventor of the subject matter involved. *Helvering* v. *Taylor*, 293 U. S. 507, 511, 79 L. Ed. 623, 627. *Helis* v. *Ward*, 308 U. S. 365, 370, 84 L. Ed. 327, 329. Since not the "first inventor", Petitioner is not entitled "to receive a

patent." *Milburn* v. *Davis-Bournonville*, 270 U. S. 390, 402, 70 L. Ed. 651, 654.

Disentitled to a patent by his own action, Petitioner has no standing under R. S. 4915. It avails him nothing. Neither the affirmance nor the reversal of the judgment below would make any difference as regards Petitioner's right under R. S. 4915 to a judgment authorizing the Commissioner to issue him a patent. Under such circumstances, this Court holds that a case or controversy does not exist. *Little* v. *Bowers*, 134 U. S. 547, 556, 33 L. Ed. 1016, 1020.

II

Absent a Case or Controversy, the "Question Presented" Is Moot and Not Subject to Review by This Court

The Constitution limits the exercise of the judicial power to "cases" and "controversies". *Aetna Life Ins. Co.* v. *Haworth*, 300 U. S. 227, 240, 81 L. Ed. 617, 620. Thus, a case or controversy under R. S. 4915 being absent, the "Question Presented" is abstract or moot and will not be considered by this Court. *Mills* v. *Green*, 159 U. S. 651, 653, 40 L. Ed. 293, 294; *Heitmuller* v. *Stokes*, 256 U. S. 359, 361, 65 L. Ed. 990, 992; *United States* v. *Munsingwear*, 340 U. S. 36, 39, 95 L. Ed. 36, 41 and cases there cited.

It matters not when the event occurred which rendered it impossible for this Court to grant Petitioner (plaintiff) any effectual relief or, except as to costs, that the event occurred, as here, through an act of Petitioner, *Heitmuller* v. *Stokes*, 256 U. S. 359, 361, 65 L. Ed. 990, 992.

The rule of this Court on questions which become moot pending appeal or review without fault of defendant is to dismiss the appeal. *Mills* v. *Green*, 159 U. S. 651, 653, 40 L. Ed. 293, 294; *Heitmuller* v. *Stokes*, 256 U. S. 359, 361,

65 L. Ed. 990, 992; *United States* v. *Munsingwear*, 340 U. S. 36, 39, 95 L. Ed. 36, 41. As said in *Mills* v. *Green*:—

> "The duty of this court, as of every other judicial tribunal, is to decide actual controversies by a judgment which can be carried into effect, and not to give opinions upon moot questions or abstract propositions, or to declare principles or rules of law which cannot affect the matter in issue in the case before it. It necessarily follows that when, pending an appeal from the judgment of a lower court, and without any fault of the defendant, an event occurs which renders it impossible for this court, if it should decide the case in favor of the plaintiff, to grant him any effectual relief whatever, the court will not proceed to a formal judgment, but will dismiss the appeal. And such a fact, when not appearing on the record, may be proved by extrinsic evidence. Lord v. Veazie, 8 How. 251, 12 L. Ed. 1067; California v. San Pablo & T. R. Co., 149 U. S. 308, 37 L. Ed. 747, 13 Sup. Ct. Rep. 876." See also United States v. Hamburg-Amerikanische Packetfahrt-Actien Gesselschaft, 239 U. S. 466, 476, 60 L. Ed. 387, 391, 36 Sup. Ct. Rep. 212, and cases cited.

III

No Conflict Exists Between Decisions under R.S. 4915 on Denial of Relief to a Plaintiff Who Concedes He Is Not the First Inventor of the Subject Matter Involved.

In alleging conflict between the decision below and decisions of courts of appeals of other circuits, Petitioner cites three cases:

Knutson v. *Gallsworthy* (C. A. D. C.), 164 F. 2d 497;
Minneapolis Honeywell Co. v. *Milwaukee Gas Co.* (C. C. A. 7), 174 F. 2d 203; and
Triplett v. *Line Material Co.* (C. C. A. 7), 133 F. 2d 533.

In all of the cited cases, priority of invention was continuously asserted by the plaintiff. In none did the court

hold that the issue of patentability should be determined when the plaintiff had conceded he was not the first inventor.

Petitioner has therefore cited no cases of conflict in the decisions of courts of appeals of different circuits on the "Question Presented" under the circumstances here existing.

No conflict in decisions having been shown, the ground upon which petitioner relies for granting the writ of certiorari completely vanishes.

Conclusion

As the "Question Presented" is moot and there is no conflict in the decisions under the circumstances here existing, the Petition should be denied.

Respectfully submitted,

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